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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,105	12/29/2000	James M. Rogers	20009.0050US01 (BS00-139)	6282

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/750,105	ROGERS ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-11 and 21* is/are pending in the application.

4a) Of the above claim(s) *21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 6-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claim 21 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 17 January 2007.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3 and 6-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6, and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (US Pat No. 6,698,020).

Regarding claim 1, Zigmond et al. discloses a "method for inserting targeted advertisements into a media delivery stream during broadcast media program" using the apparatus of Figure 3. As illustrated in Figure 5, the method comprises "storing data files representing a plurality of advertisement in a media delivery device" [80] in a "database"

[86] or organized data structure containing a number of records in the form of advertisements that "includes . . . classifying the stored advertisements according to a plurality of categories" (Col 11, Lines 37-42; Col 12, Lines 26-32) wherein the "stored advertisements are each of a type that is determined to appeal to one or more users of the media delivery device" (Col 12, Lines 15-24; Col 13, Lines 7-12). The apparatus "receives a signal in the media delivery device" associated with the vertical blanking interval "to insert a stored advertisement into the media delivery stream during broadcast media programming wherein the signal to insert the stored advertisement is sent with the broadcast media programming" (Col 15, Lines 35-65). The 'signal' associated with the vertical blanking interval may also contain . . . [and] includes at least one classification for one or more categories as provided in the table for selecting a commercial stored in the database for insertion into the media delivery stream" (Col 11, Lines 31-49; Col 11, Line 66 – Col 12, Line 32; Col 16, Lines 43-56). The apparatus "inserts an advertisement stored in the database into the media delivery stream" (Col 15, Lines 56-65). Subsequently, the system "transmits a request form the media delivery device to an external network through a telecommunications link to receive the plurality of advertisements for storage in the media delivery device" (Col 15, Lines 2-16).

Claim 2 is rejected wherein the "advertisements are television commercials" (Col 1, Lines 14-22; Col 7, Lines 13-25).

Claim 3 is rejected wherein the "media delivery device is a set top box for receiving broadcast signals for a cable or satellite television network system" (Col 7, Lines 1-12 and 37-51).

Claim 6 is rejected wherein the method further comprises the "steps of searching the table in the database for at least one advertisement having a classification in at least one category that is provided in the signal" (Col 11, Lines 31-49).

Claim 8 is rejected wherein the "plurality of stored advertisements are received by the media delivery device as encoded data files through the telecommunications link to an external database of advertisements" (Col 14, Line 66 – Col 15, Line 17; Col 15, Lines 24-34).

Claim 9 is rejected wherein the method further comprises "transmitting signals between the media delivery device and the external network indicating the one or more types of advertisements that appeal to users of the media delivery device" (Col 9, Lines 21-38) and "classifying the stored advertisements according to a plurality of categories, which includes a classification according to the type of advertisement that is stored" (Col 11, Lines 37-42; Col 12, Lines 26-33).

Claim 10 is rejected wherein "after transmitting the request, receiving download signals from the broadcast media stream in the media deliver device to download the data files representing the advertisements for storage in the media delivery device, wherein for each advertisement the signals include a classification for one or more categories as provided in the table for selecting an advertisement stored in the database for insertion into the media delivery stream" (Col 12, Lines 26-33; Col 14, Line 66 – Col 15, Line 16) and "downloading the data files representing the advertisements having a classification for one or more of the categories as provided in the table that matches a pre-stored classification in a list of

classification indicating the one or more types of advertisements that appeal to users of the media delivery device" (Col 14, Lines 24-27; Col 15, Lines 17-23).

Claim 11 is rejected wherein "categories in the table include one or more of: . . . type of product advertised" (Col 14, Lines 24-27).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1-3, 6, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat No. 6,698,020) in view of Ficco (US Pub No. 2005/0166244 A1).

Regarding claim 1, Zigmond et al. discloses a "method for inserting targeted advertisements into a media delivery stream during broadcast media program" using the apparatus of Figure 3. As illustrated in Figure 5, the method comprises "storing data files

representing a plurality of advertisement in a media delivery device" [80] in a "database" [86] or organized data structure containing a number of records in the form of advertisements that "includes . . . classifying the stored advertisements according to a plurality of categories" (Col 11, Lines 37-42; Col 12, Lines 26-32) wherein the "stored advertisements are each of a type that is determined to appeal to one or more users of the media delivery device" (Col 12, Lines 15-24; Col 13, Lines 7-12). The apparatus "receives a signal in the media delivery device" associated with the vertical blanking interval "to insert a stored advertisement into the media delivery stream during broadcast media programming wherein the signal to insert the stored advertisement is sent with the broadcast media programming" (Col 15, Lines 35-65). The 'signal' associated with the vertical blanking interval may also contain . . . [and] includes at least one classification for one or more categories as provided in the table for selecting a commercial stored in the database for insertion into the media delivery stream" (Col 11, Lines 31-49; Col 11, Line 66 – Col 12, Line 32; Col 16, Lines 43-56). The apparatus "inserts an advertisement stored in the database into the media delivery stream" (Col 15, Lines 56-65). Subsequently, the system "transmits a request form the media delivery device to an external network through a telecommunications link to receive the plurality of advertisements for storage in the media delivery device" (Col 15, Lines 2-16).

While the Zigmond et al. advertisement repository [86] may be construed as a database comprising both the video itself as well as advertisement parameters, it is unclear if the 'database' is necessarily organized by "tables" per se. In an analogous art pertaining to apparatus for selecting and insetting commercial advertisements into television programming, the Ficco reference provides evidence of fact that it is known in the art to

utilizes a "database . . . that includes a table for classifying the stored advertisements according to a plurality of categories" (Para. [0036]). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zigmond et al. to employ a 'database' as claimed for the purpose of providing an efficient means for searching for records within storage in addition to providing for the ability to further provide no only targeted but also highly individualized advertising (Ficco et al.: Para. [0005]).

Claim 2 is rejected wherein the "advertisements are television commercials" (Zigmond et al.: Col 1, Lines 14-22; Col 7, Lines 13-25).

Claim 3 is rejected wherein the "media delivery device is a set top box for receiving broadcast signals for a cable or satellite television network system" (Zigmond et al.: Col 7, Lines 1-12 and 37-51).

Claim 6 is rejected wherein the method further comprises the "steps of searching the table in the database for at least one advertisement having a classification in at least one category that is provided in the signal" (Zigmond et al.: Col 11, Lines 31-49).

Claim 8 is rejected wherein the "plurality of stored advertisements are received by the media delivery device as encoded data files through the telecommunications link to an external database of advertisements" (Zigmond et al.: Col 14, Line 66 – Col 15, Line 17; Col 15, Lines 24-34).

Claim 9 is rejected wherein the method further comprises "transmitting signals between the media delivery device and the external network indicating the one or more types of advertisements that appeal to users of the media delivery device" (Zigmond et al.: Col 9,

Lines 21-38) and "classifying the stored advertisements according to a plurality of categories, which includes a classification according to the type of advertisement that is stored" (Zigmond et al.: Col 11, Lines 37-42; Col 12, Lines 26-33).

Claim 10 is rejected wherein "after transmitting the request, receiving download signals from the broadcast media stream in the media deliver device to download the data files representing the advertisements for storage in the media delivery device, wherein for each advertisement the signals include a classification for one or more categories as provided in the table for selecting an advertisement stored in the database for insertion into the media delivery stream" (Zigmond et al.: Col 12, Lines 26-33; Col 14, Line 66 – Col 15, Line 16) and "downloading the data files representing the advertisements having a classification for one or more of the categories as provided in the table that matches a pre-stored classification in a list of classification indicating the one or more types of advertisements that appeal to users of the media delivery device" (Zigmond et al.: Col 14, Lines 24-27; Col 15, Lines 17-23).

Claim 11 is rejected wherein "categories in the table include one or more of . . . type of product advertised" (Zigmond et al.: Col 14, Lines 24-27).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat No. 6,698,020), in view of Ficco (US Pub No. 2005/0166244 A1), and in further view of Hite (US Pat No. 5,774,170).

In consideration of claim 7, Zigmond et al. teaches that the "at least one advertisement is a plurality of advertisements" and further contemplates the situation that multiple advertisements may meet the specified advertisement selection criteria (Col 16, Line 65 –

Col 17, Line 9) whereupon the system selects a particular ad for display. Furthermore, the reference teaches that those skilled in the art would recognize the particular usage of other ad selection criteria (Col 14, Lines 59-65). However, the reference is silent such that the "step of selecting an advertisement from the at least one advertisement having a classification provided in the signal by weighing the relative importance of each category in the table". In an analogous art pertaining to apparatus for selecting and insetting commercial advertisements into television programming, Hite et al. teaches that the "step of selecting an advertisement from the at least one advertisement having a classification provided in the signal by weighing the relative importance of each category in the table" (Col 6, Lines 28-39). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zigmond et al. such that the "step of selecting an advertisement from the at least one advertisement having a classification provided in the signal by weighing the relative importance of each category in the table" for the purpose of enhancing the system through the usage of selection rules which dictate what to do in case of multiple matches.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Beliveau
Primary Examiner
Art Unit 2623

SEB
February 20, 2007